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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/830,082 | 04/23/2004 | Guglielmo Biagiotti | 6299/CONT | 9225 |
| 7590 01/13/2006 Breiner & Breiner, L.L.C. P. O. Box 19290 Alexandria, VA 22320-0290 | | | EXAMINER LONEY, DONALD J | |
| | | | ART UNIT 1772 | PAPER NUMBER |
| DATE MAILED: 01/13/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/830,082 | Applicant(s) BIAGIOTTI, GUGLIELMO | |
| | Examiner Donald Loney | Art Unit 1772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-109 is/are pending in the application.
- 4a) Of the above claim(s) 69-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/601,842.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I in the reply filed on October 25, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 58-65, 67 and 68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 58 and 66, it is recited that certain protuberances are "squeezed at positions". It is unclear as to the meaning and/or structure thereof. Clarification is kindly requested in order to clearly understand the scope of the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 54, 56, 57, 61, 65 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by either Walburn (4307141) or WO 95/35205 to Ruppel et al.

Both references disclose an embossed product comprising two layer wherein the first layer has a first set of protuberances making up a background pattern and a second set of protuberances of major dimension (i.e. deeper) and minor density (i.e. there are less thereof) wherein the two layers are bonded with adhesive only at the second set of protuberances (i.e. the larger ones). Refer to figures 2 and 3 in Walburn showing second set of major dimension protuberances 24, 25 and the first set of smaller, more dense, protuberances 26 along with column 2, lines 25-52. The examiner will refer to US Pat. No 5846636 in reference to WO 95/35205 since it is an English language equivalent thereof. The examiner has applied the WO document since it has an earlier publication date and is prior art under 102(b). Refer to figures 2 and 4 along with the Abstract, column 2, lines 7-61, column 4, lines 5-30 and the corresponding section for figure 4. The first protrusions 12 of Ruppel et al are equivalent to the applicants' second set of protrusions since they are less dense and have more dimension than the second protrusion 12, which are equivalent to the applicants' first set of protrusions since they are more dense and less dimension second set. From figure 4 it can be seen that the bigger dimension protrusion 51 is the one with adhesive while the smaller ones are disclosed as adhesive free in Ruppel. For claim 56, the second sheet 22 in Walburn and 6 in Ruppel contain embossments. Per claim 57, the second embossed sheet 22 has major dimensions as shown in figure 3 at 22b in Walburn. Per claim 61, the sheets are bonded by at least some of the third set of protrusions 22b in Walburn. Per claim 65, minor protrusions 22a are shown on the second sheet of Walburn. Per claim 66, all protuberances are facing inward in both references.

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6. Claims 54, 56, 57, 61, 62, 64, 65 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by either Schulz (4320162) or WO 97/44528 to Barnholtz.

Both references disclose a embossed product comprising two layer wherein the first layer has a first set of protuberances making up a background pattern and a second set of protuberances of major dimension (i.e. deeper) and minor density (i.e. there are less thereof) wherein the two layers are bonded with adhesive only at the second set of protuberances (i.e. the larger ones). Refer to figures 2 and 3 in Schulz showing first protuberances 25 and second protuberances 24. The second ones contain major dimension and are less dense than the first ones. Refer to figure 1B in Barnholtz showing first protuberances 184 and second protuberances 35. The second ones contain major dimension and are less dense than the first ones. The sheets are bonded by the second set of protuberances in both references. For claim 56, the second sheet 22 in Schultz and 32 in Barnholtz contain embossments. Per claim 57, the second embossed sheet 22 has major dimensions 26 as shown in figure 3 of Schulz. Per claim 61, the sheets are bonded by at least some of the third set of protrusions 26 in Schultz. Per claim 65, minor protrusions 27 in Schultz and 184 in Barnholtz are shown on the second sheet. Per claim 66, all protuberances are facing inward in both references (see figure 2A in Barnholtz and figure3 in Schultz. This rejection was specifically made to address claims 62 and 64, not included in the rejections over Walburn and Ruppel above, since Schulz and Barnholtz disclose a third layer (see figure 2A in Barnholtz and figure 8 in Schulz.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of Walburn, Schulz, Ruppel or Barnholtz in view of Murphy (3684641).

The primary references teach the invention substantially as claimed except for the use of colored adhesive to bond the webs. See 35 USC 102 rejections above.

Murphy discloses it is known to bond creped webs with colored adhesive in order to form an aesthetically pleasing coloration visible on the exterior surface of the webs. Refer to column 1, lines 12-18 and column 2, lines 5-72.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to bond the webs together using colored adhesive, as taught by Murphy, in order to form an aesthetically pleasing coloration visible on the exterior surface of the webs.

Allowable Subject Matter

10. Claim 59 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose, teach or fairly suggest the third set of protuberances inserted inside the second set of protuberances.

12. The continuity in the specification should be updated. Also, the examiner notes foreign references scanned in the application, however, no IDS with a PTOL 1449 has been included for the examiner to initial and date any references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney
Primary Examiner
Art Unit 1772

DJL:D.Loney
01/09/06